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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			CAMPBELL, JOSHUA D	
			ART UNIT	PAPER NUMBER
			2178	

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/636,039

Applicant(s)

GRAHAM ET AL.

Examiner

Joshua D. Campbell

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-19,30-38,40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-19,30-38,40 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>4/5/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: RCE and IDS filed on 4/5/2006.
2. Claims 11-19, 30-38, 40 and 41 are pending in this case. Claims 11, 19, 30, 38, 40, and 41 are independent claims. Claims 11, 14-16, 19, 30, 33-35, 38, 40, and 41 have been amended. Claims 1-10, 20-29, and 29 have been cancelled.
3. The rejection of claims 1, 9, 20, 28, and 39 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 29, 30, 33, 39, 40, 43, 44, 47, 53, 54, 57, 58, and 59 of U.S. Patent No. 10/214,380 has been due to the cancellation of the rejected claims.
4. The rejection of Claims 11 and 30 under 35 U.S.C. 102(a) as being anticipated by Acrobat Reader (hereinafter Acrobat, Adobe Acrobat Reader, published in 1999) has been withdrawn due to amendments.
5. The rejection of Claims 12, 13, 17, 18, 31, 32, 36, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acrobat Reader (hereinafter Acrobat, Adobe Acrobat Reader, published in 1999) has been withdrawn due to amendments.

Claim Rejections - 35 USC § 103

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 11-15, 17-19, 30-34, 36-38, and 40-41 are rejected under 35

U.S.C. 103(a) as being unpatentable over Acrobat Reader (hereinafter Acrobat, Adobe Acrobat Reader, published in 1999) in view of Nielsen (US Patent Number 6,339,437, filed on September 30, 1997) and further in view of Hart et al. (hereinafter Hart, US Patent Number 5,546,502, issued August 13, 1999).

In regard to independent claim 11, Acrobat discloses a method in which a document is accessed and a section of that document is shown in a first area and thumbnails of the document are displayed in a second area (Page 1-3 of Acrobat). Acrobat also discloses a method in which information about the contents of a document; including dimensions and locations of items (coordinates) are determined, in order to correctly place the information in the thumbnail representation (Page 1-3 of Acrobat). Acrobat also discloses that the portion of the thumbnail window corresponding to the part of the document being displayed is highlighted (emphasized) and changed dynamically as the portion that is viewed is changed to a different portion (Page 1-4, items 1-4 of Acrobat, the box in the thumbnail changes based on the portion being viewed). Acrobat discloses a method in which determining information about a document (coordinates and dimension) includes determining information about text, forms, graphics, images, and links (Pages 1-5 of Acrobat).

Acrobat does not disclose that text entities are annotated according to style information if they are relevant to any of a plurality (first and second) of concepts. However, Nielsen discloses a method in which a document is accessed and it is searched to identify text patterns that are relevant to user queries (plurality of concepts),

which are received from the user (column 1, line 17-column 2, line 16 of Nielsen).

Nielsen discloses a method in which search terms are supplied via user queries and a document is searched to identify text patterns that match those search terms (column 1, line 17-column 2, line 16 of Nielsen). The text patterns that match the queries are then marked using tags and highlighted with color (annotated) to emphasize their position as the document is viewed (column 1, line 17-column 2, line 16 of Nielsen). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Acrobat with the method of searching a document by Nielsen because it would have provided a user with a simple way to search and identify terms when viewing a document.

Neither Acrobat nor Nielsen disclose a method in which the selects from plurality of concepts rather than entering a query, the concepts having keywords associated with them. However, Hart discloses a method in which a user selects concepts (symptoms) and the system searches for the concepts and commonly known keywords (faults) associated with the concepts in the document and presents the sections of the document that deal with the concepts and text patterns associated with the concepts (symptoms and faults) out to the user (column 3, line 39-column 4, line 61 of Hart). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Acrobat and Nielsen with the query-free teachings of Hart because it would have provided relevant documentation for the current context more efficiently without the user having to formulate a query and wait for results (column 6, lines 31-44 of Hart).

In regard to dependent claim 12, Acrobat discloses a method in which information about the contents of a document; including dimensions and locations of items (coordinates) are determined, in order to correctly place the information in the thumbnail representation (Page 1-3 of Acrobat).

In regard to dependent claim 13, Acrobat discloses a method in which the thumbnail sizes can be changed to a different reduction level (reduction ratio) and the content still correctly corresponds to the original document (Page 1 and 5, items 1 and 5 of Acrobat).

In regard to dependent claim 14, neither Acrobat nor Nielsen disclose a method in which the selects from plurality of concepts rather than entering a query, the concepts having keywords associated with them. However, Hart discloses a method in which a user selects concepts (symptoms) and the system searches for the concepts and commonly known keywords (faults) associated with the concepts in the document and presents the sections of the document that deal with the concepts and text patterns associated with the concepts (symptoms and faults) out to the user (column 3, line 39-column 4, line 61 of Hart). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Acrobat and Nielsen with the query-free teachings of Hart because it would have provided relevant documentation for the current context more efficiently without the user having to formulate a query and wait for results (column 6, lines 31-44 of Hart).

In regard to dependent claim 15, Acrobat discloses a method in which the thumbnail representations of the document incorporate all formatting of that document which would include highlighted text entities (Pages 1-5 of Acrobat).

In regard to dependent claim 17, Acrobat discloses a method in which determining information about a document (coordinates and dimension) for creating thumbnail representations of the document incorporate all formatting of that document (Pages 1-5 of Acrobat).

In regard to dependent claim 18, Acrobat discloses a method in which determining information about a document (coordinates and dimension) includes determining information about text, forms, graphics, images, and links (Pages 1-5 of Acrobat).

In regard to independent claim 19, Acrobat discloses a method in which a document is accessed and a section of that document is shown in a first area and thumbnails of the document are displayed in a second area (Page 1-3 of Acrobat). Acrobat also discloses a method in which information about the contents of a document; including dimensions and locations of items (coordinates) are determined, in order to correctly place the information in the thumbnail representation (Page 1-3 of Acrobat). Acrobat also discloses that the portion of the thumbnail window corresponding to the part of the document being displayed is highlighted (emphasized) and changed dynamically as the portion that is viewed is changed to a different portion (Page 1-4, items 1-4 of Acrobat, the box in the thumbnail changes based on the portion being viewed).

Acrobat does not disclose that text entities are annotated according to style information if they are relevant to any of a plurality of concepts. However, Nielsen discloses a method in which a document is accessed and it is searched to identify text patterns that are relevant to user queries (plurality of concepts), which are received from the user (column 1, line 17-column 2, line 16 of Nielsen). Nielsen discloses a method in which search terms are supplied via user queries and a document is searched to identify text patterns that match those search terms (column 1, line 17-column 2, line 16 of Nielsen). The text patterns that match the queries are then marked using tags and highlighted with color (annotated) to emphasize their position as the document is viewed, in a manner that is independent of a second query being made (column 1, line 17-column 2, line 16 of Nielsen). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Acrobat with the method of searching a document by Nielsen because it would have provided a user with a simple way to search and identify terms when viewing a document.

Neither Acrobat nor Nielsen disclose a method in which the selects from plurality of concepts rather than entering a query, the concepts having keywords associated with them. However, Hart discloses a method in which a user selects concepts (symptoms) and the system searches for the concepts and commonly known keywords (faults) associated with the concepts in the document and presents the sections of the document that deal with the concepts and text patterns associated with the concepts (symptoms and faults) out to the user (column 3, line 39-column 4, line 61 of Hart). It

would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the methods of Acrobat and Nielsen with the query-free teachings of Hart because it would have provided relevant documentation for the current context more efficiently without the user having to formulate a query and wait for results (column 6, lines 31-44 of Hart).

In regard to independent claim 30 and dependent claims 31-34 and 36-37, the claims incorporate substantially similar subject matter as claims 11-15 and 17-18. Thus, the claims are rejected along the same rationale as claims 11-15 and 17-18.

In regard to independent claims 38 and 40-41, the claims incorporate substantially similar subject matter as claim 19. Thus, the claims are rejected along the same rationale as claim 19.

8. Claims 16 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Acrobat Reader (hereinafter Acrobat, Adobe Acrobat Reader, published in 1999) in view of Nielsen (US Patent Number 6,339,437, filed on September 30, 1997) further in view of Hart et al. (hereinafter Hart, US Patent Number 5,546,502, issued August 13, 1999) and further in view of Okamoto et al. (hereinafter Okamoto, US Patent Application Publication Number 2002/0065814, US Filing date June 30, 1999).

In regard to dependent claim 16, none of Acrobat, Nielsen, or Hart disclose a method in which the style information relevant to a concept is modified and in response all entities that correspond to that concept are changed to correspond with the new style information. However, Okamoto discloses a method in which a concept tag number,

which corresponds to one of a plurality of concepts, is directly associated with a specific style (page 12, paragraph 0270-0276 of Okamoto). When that style information is changed all tags corresponding to the tag number associated with that style information will reflect that change (page 12, paragraph 0270-0276 of Okamoto). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have combined the method of viewing a document by Acrobat with the method of searching a document by Okamoto because it would have provided a user with a simple way to search and customize the identification of terms when viewing a document.

In regard to dependent claim 35, the claim incorporates substantially similar subject matter as claim 16. Thus, the claim is rejected along the same rationale as claim 16.

Response to Arguments

9. Applicant's arguments filed 4/5/2006 have been fully considered but they are not persuasive.

Regarding applicant's arguments on pages 11-14 with respect to claims 11, 19, 30, 38, 40, and 41, the examiner maintains that the rejection is proper. The amendment to the claim states, "...the single thumbnail image displaying the contents of the document in a continuous non-paginated form." Acrobat also discloses a method in which information about the contents of a document; including dimensions and locations of items (coordinates) are determined, in order to correctly place the information in the thumbnail representation (Page 1-3 of Acrobat). Acrobat also discloses that the portion

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of the thumbnail window corresponding to the part of the document being displayed is highlighted (emphasized) and changed dynamically as the portion that is viewed is changed to a different portion (Page 1-4, items 1-4 of Acrobat, the box in the thumbnail changes based on the portion being viewed). Which as stated changes the display of the contents of the thumbnail image (replacing the viewing window based on where in the document the user is viewing), not the actual contents of the thumbnail image. If a document exists without pagination, for instance a single page document or a web-page style document that is large without page breaks the thumbnail image also contains no document. The evidence shown by Adobe Creative Team (Adobe Acrobat 4.0 Classroom in a Book, second edition) shows that documents such as this (i.e. web-page style document with a single page that is very large) can be created and viewed in Acrobat 4.0 (Pages 1-4 "Settings options for converting Web pages" emphasis on sizing abilities on Page 4, Item "11"), which would create thumbnail images without pagination in response.

Applicant also argues the limitation that the first concept and the indication of relevancy for the first concept is independent of a second concept selected. Nielsen discloses a method in which a document is accessed and it is searched to identify text patterns that are relevant to user queries (plurality of concepts), which are received from the user (column 1, line 17-column 2, line 16 of Nielsen). Nielsen discloses a method in which search terms are supplied via user queries and a document is searched to identify text patterns that match those search terms (column 1, line 17-column 2, line 16 of Nielsen). Hart is merely referenced to point out the obviousness to one of ordinary

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skill in the art of the ability to generate a query via selection rather than having to manually derive the entire query. The Hart reference simply shows the process of generating one single query, while the Nielsen reference discloses the information necessary to understand how multiple queries could be handled independently of each other. Thus, in the claims current form they do not overcome the rejection by the Acrobat reference as stated.

Regarding applicant's arguments on pages 14 and 15 with respect to claims 12-18 and 31-37, the examiner maintains that the rejection is proper. Hart discloses a method in which a user selects concepts (symptoms) and the system searches for the concepts and commonly known keywords (faults) associated with the concepts in the document and presents the sections of the document that deal with the concepts and text patterns associated with the concepts (symptoms and faults) out to the user (column 3, line 39-column 4, line 61 of Hart).

Conclusion

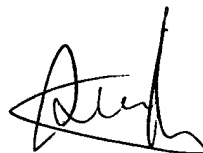
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joshua D. Campbell whose telephone number is (571) 272-4133. The examiner can normally be reached on M-F (7:30 AM - 4:00 PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on (571) 272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JDC
June 1, 2006



STEPHEN HONG
SUPERVISORY PATENT EXAMINER